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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,353	08/17/2001	Herbert Bachler	33891	4874

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/932,353

Applicant(s)

BACHLER ET AL.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13-19, 21-33 and 36-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 28-33 is/are allowed.
- 6) ☐ Claim(s) 13-16, 19, 21-27 and 36-44 is/are rejected.
- 7) ☐ Claim(s) 17 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. Claim 19 is objected to because of the following informalities: lines 1 – 2 state, “one of claims 13”. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 13, 14, 19, 21 and 23 – 26 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,606,329 to Hough.

In reference to claim 13, Hough discloses an implanted hearing aid with at least one permanent magnet (50) (Figure 8) adapted for being solidly attached on a promontory in the area of the middle ear as well as one coil separate from the magnet adapted for placing in the area of the middle ear (37, Figure 3). It has been held that the recitation that an element is “adapted to “perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

In reference to claim 14, Hough shows the coil (37) being adapted for placing in the area of the ossicle chain.

In reference to claim 19, Hough shows the permanent magnet being one of a circular, oval, square, or rectangular design (Figure 6). Additionally, Hough discloses the magnet having any desirable shape or form (Col. 7, lines 4 – 5).

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In reference to claims 21 and 26 Hough discloses the permanent magnet (50) being adapted to be solidly attached to the promontory (Col. 7, lines 30 – 37). Because of the clip structure associated with the magnet as shown in Figure 6, the magnet is adapted to be removeably attached or adjustable.

In reference to claims 23 – 25, the coil disclosed by Hough is considered by the examiner to extend in a plain parallel, perpendicular, and between 0° and 180° relative to the magnet (Figure 8).

3. Claims 13 – 16, 21, 22, 26, 36 – 38, 40 – 42 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,084,975 to Perkins.

In reference to claim 13 – 16, 21, 22, 26, 36 – 38, 40 – 42 and 44, Hough discloses an implanted hearing aid with at least one permanent magnet (50) (Figure 8) adapted for being solidly attached on a promontory in the area of the middle ear as well as one coil separate from the magnet adapted for placing in the area of the middle ear (37, Figure 3). It has been held that the recitation that an element is “adapted to “ perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Hough shows the coil (37) being adapted for placing in the area middle ear in the area of the ossicle chain (Col. 3, lines 22 – 24). Because Hough discloses the coil being placed within the middle ear, the coil is considered by the examiner to be adapted to be placed at or behind the tympanic membrane. Hough discloses the removability of the permanent magnet (Col. 4, lines 26 – 28). The removability of the magnet is considered by the examiner to be adjustable.

Furthermore, it is well established that a recitation with respect to the manner in which an apparatus is intended to be employed, i.e., a functional limitation, does not impose any structural limitation upon the claimed apparatus which differentiates it from a prior art reference disclosing the structural limitations of the claim. *In re Pearson*, 494 F.2d 1399, 181 USPQ 641 (CCPA 1974); *In re*

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*Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967); *In re Otto*, 312 F.2d 937, 136 USPQ 458 (CCPA 1963). Where the prior art reference is inherently capable of performing the function described in a functional limitation, such functional limitation does not define the claimed apparatus over such prior art reference, regardless of whether the prior art reference explicitly discusses such capacity for performing the recited function. *In re Ludtke*, 441 F.2d 660, 169 USPQ 563 (CCPA 1971). In addition, where there is reason to believe that such functional limitation may be an inherent characteristic of the prior art reference, Applicant is required to prove that the subject matter shown in the prior art reference does not possess the characteristic relied upon. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990); *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986); *In re Ludtke*, 441 F.2d at 664, 169 USPQ at 566 (CCPA 1971). In the present case, the magnet and coil as disclosed by Perkins are capable of being placed at locations within the middle ear as desired.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 39 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,084,975 to Perkins.

In regards to claims 39 and 43, Perkins discloses an air-gap between a permanent magnet and a coil (Figure 1), but does not disclose the air-gap being adjustable. However, adjustability, where desirable, is a modification that is within the skill of the art. *In re Stevens*, 212 F.2d 197, 101

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USPQ 284 (CCPA 1954). In the present case it would be desirable, and thus an obvious modification to one having ordinary skill in the art at the time the invention was made, to adjust the air-gap between the magnet and the coil in order to increase or reduce the intensity of the mechanical oscillation.

### *Allowable Subject Matter*

6. Claims 28 – 33 are allowed. No prior art teaches or fairly suggests Applicant's claimed method where electrical signals are converted into mechanical oscillations of a coil positioned in a middle ear by utilizing a permanent magnet separate from the coil that is solidly attached to the promontory.

7. Claims 17 and 18 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (703) 305-5390. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mary Beth Jones can be reached on (703) 308-3400. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



JMLF  
April 18, 2004

*Mary Beth Quinn*  
*Acting SPC*  
*AU 3736*